

REMARKS

Upon entry of the present Amendment, claims 1-15 and 17-23 will be pending in the Application.

Claim 1 has been amended for clarification.

Claims 27 and 28 have been canceled without prejudice.

No claims have been added.

No new matter has been introduced by the foregoing amendments.

Amendments to and cancellation of the claims, as set forth above, are made in order to streamline prosecution in this case by limiting examination and argument to certain claimed embodiments that presently are considered to be of immediate commercial significance. Amendment or cancellation of the claims is not in any manner intended to, and should not be construed to, waive Applicants' right in the future to seek such unamended or cancelled subject matter, or similar matter (whether in equivalent, broader, or narrower form) in the present application, and any continuation, divisional, continuation-in-part, RCE, or any other application claiming priority to or through the present application, nor in any manner to indicate an intention, expressed or implied, to surrender any equivalent to the claims as pending after such amendments or cancellations

Reconsideration is respectfully requested in view of the foregoing amendments and/or following remarks.

1. Rejection under 35 U.S.C. §112.

Claim 1 has been amended for clarification to address the Examiner's concern. Applicants respectfully submit that the rejection under 35 U.S.C. §112 is now moot in view of the foregoing amendment. Withdrawal of this rejection is respectfully requested.

2. **Rejection of claims 1-15, 17-23, and 27-28 under 35 U.S.C. §103(a) as allegedly unpatentable over DE10042152 as translated by U.S. Patent No. 7,019,042 to Röckrath et al., hereafter "Rockrath", in view of U.S. Patent No. 5,064,871 to Sciangola, hereafter "Sciangola".**

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, or knowledge generally available in the art at the time of the invention, must provide some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1998).

Applicants respectfully submit that independent claim 1 recites that the rheological aid comprises the urea derivative (A) in an amount, based on the rheological aid, of more than 10% by weight.

The Examiner is of the opinion that this amount encompasses the bismuth catalyst. (3/19/2008 Office Action, page 7, first full paragraph).

Applicants respectfully submit that in the amendment filed January 17, 2008, independent claim 1 was amended to clarify that the more than 10% by weight does not include the bismuth catalyst. Therefore, Applicants respectfully assert that 10% by weight is in reference to the urea derivative alone, and not the combination of the urea derivative and the bismuth catalyst.

Those of skill in the art reading Applicants' Specification understand that the term "urea derivative" refers to the reaction product of reactants (a1) and (a2). Indeed, Applicants' Specification on page 7, ll 22 through page 8, line 6, expressly indicates that the term "urea derivative" refers to the reaction product of (a1) and (a2) while page 9, ll 9-11 indicate that this reaction product is made in the presence of the compound (a3). Thus, Applicants' amended language of independent claim 1 merely clarifies the claimed invention and does not add any new matter.

Applicants respectfully submit that the known liquid rheological aids contain the crystalline urea derivatives only in an amount of up to 10% by weight, based on the rheological aid. This means that a comparatively large amount of liquid rheological aid must be incorporated into the coating materials, particularly into the high-solids clearcoat materials, in order to obtain an amount of crystalline urea derivatives sufficient for positively influencing the rheology. As a result of the comparatively large amount of liquid rheological aid, however, the solids content of the coating materials is undesirably lowered. Attempts have been made to counter this problem by raising the amount of crystalline urea derivatives in the known, liquid rheological aids. In the majority of cases, however, this results in the liquid rheological aids in question being barely still fluid and therefore subsequently being difficult if not impossible to process. (Application as filed, page 3, line 23, to page 4, line 8).

The above disclosed state of the art is confirmed by Rockrath. Rockrath discloses that the thixotropic agent comprises the urea crystals in an amount, based on the thixotropic agent, of from 0.1 to 10, more preferably from 0.2 to 9, with particular preference from 0.3 to 8, with very particular preference from 0.4 to 7, and in particular from 0.5 to 6% by weight. (Rockrath, column 4, lines 47-53, examples, claim 11).

Therefore, Rockrath does not teach or suggest the presence of Applicants' urea derivative (A) in an amount, based on the rheological aid, of more than 10% by weight. In addition, Rockrath does not provide any motivation for one with ordinary skill in the art to use the urea crystals in an amount of greater than 10% by weight, since the state of the art, as disclosed by Applicants, is that such amounts lead to adverse effects, and also since Rockrath discloses preferred ranges to be well below 10% by weight. Further, Applicants respectfully submit that the Examiner has not articulated what motivation there would be for one with ordinary skill in the art to modify Rockrath to use the urea crystals in an amount of greater than 10% by weight with a reasonable expectation of success, in view of the prior art which suggests otherwise. In this regard, the courts have held that to find obviousness, the Examiner must "identify a reason that would have prompted a person of ordinary skill in the art in the relevant field to combine the elements in the way the claimed new invention does." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct.

1727, 1741 (2007). Applicants respectfully assert that there is no such reason in view of the teaching of Rockrath and the state of the art.

In fact, it is respectfully submitted that Rockrath teaches away from using more than 10% by weight of the urea crystals. A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997), emphasis added.

Finally, Applicants must respectfully disagree with the PTO's statement that "the instantly claimed compositions do not require the bismuth catalysts to remain therein." (*Office Action of 3/19/08, Section 7, 2nd paragraph*) This is not accurate in view of the express language of amended claim 1 that requires the presence of a bismuth compound in Applicants' final claimed liquid rheological aid. As admitted by the PTO, Rockrath is silent as to this required element of the instantly claimed invention.

Applicants respectfully submit that the above deficiencies in Rockrath are not remedied by Sciangola.

Therefore, it is respectfully asserted that the present claims are patentable over Rockrath in view of Sciangola under 35 U.S.C. §103(a), at least because the combination of the prior art does not teach or suggest all the elements of independent claim 1, and further because there exists no motivation for one with ordinary skill in the art to modify Rockrath to use more than 10% by weight of urea crystals, i.e., the reaction product of (a1) and (a2), in view of the teaching of Rockrath and the state of the art. Withdrawal of this rejection and allowance of the claims is respectfully requested.

In addition, Applicants respectfully traverse the remaining assertions set forth in the Office Action, including the teachings of the various references. However, since these references fail to render the claims obvious for at least the reasons set forth above, these assertions are moot and are therefore not specifically addressed in detail.

3. **Rejection of claims 1-15, 17-23, and 27 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of Rockrath, in view of Sciangola.**

Applicants respectfully traverse the nonstatutory obviousness-type double patenting rejection in view of the above arguments. Applicants respectfully assert that the present claims do not conflict with the claims of Rockrath, in view of Sciangola. The above arguments are incorporated herein by reference in their entirety. Rockrath does not teach or suggest Applicants' presence of urea derivative (A) in an amount, based on the rheological aid, of more than 10% by weight. In fact, Rockrath teaches against it, by limiting the amount of urea crystals under 10% by weight. Withdrawal of this rejection is respectfully requested.

CONCLUSION

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

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